

REMARKS

Claims 24-65 are pending in the application.

Upon entry of the foregoing amendments claims 25, 36, 47 and 57 have been previously cancelled and claims 30, 31, 41, 52, 53, 62 and 63 are currently cancelled all without prejudice or disclaimer to the subject matter contained therein. Applicants retain the right to pursue the subject matter of any of the cancelled claims in a divisional, continuation or continuation-in-part application.

Claims 24, 33, 35, 42, 44, 46, and 56 have been amended. Bases for the amendments can be found in the application as filed. The amendments do not add any new matter within the meaning of 35 U.S.C. §132. Therefore entry of the amendments is respectfully requested.

REJECTION UNDER 35 U.S.C. §112, FIRST PARAGRAPH
– WRITTEN DESCRIPTION

The Examiner has rejected claims 24, 26-35, 37-46, 48-56 and 58-65 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The Examiner asserts that the rejected claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors, at the time application was filed, had possession of the claimed invention. Specifically, the Examiner states that the instantly claimed formulation with dimethiconol SGM-36 from Dow Corning, and that this preferred polymer has a dynamic viscosity of 6,400 Pa·s at 25°C. However, the Examiner is of the position that Weijermars also teaches SGM-36 from Dow Corning with a Newtonian/dynamic viscosity of almost 50,000 Pa·s at 25°C. See, Figure 2, Weijermars Naturwissenschaften, 1986, 73:33-34. The Examiner states that this constitutes about a 10 fold difference in viscosity for the same polymer measured at the same temperature.

Applicants traverse this rejection. Applicants respectfully submit that claims 24, 26-35, 37-46, 48-56 and 58-65 fully comply with the written description requirement of 35 USC § 112, first paragraph.

The test under 35 U.S.C. 112, first paragraph, for determining compliance with the written description requirement is whether the application clearly conveys that Applicants have invented the subject matter as claimed. *In re Barker*, 194 USPQ 470, 473 (CCPA 1977); MPEP 2163. Also, Applicants must convey to the public what Applicants claim as the invention so that the public may ascertain if Applicant claim anything in common use or

already known. MPEP § 2163. Lastly, the specification must convey that Applicants were in possession of the invention. MPEP § 2163. The Examiner is respectfully reminded that the Examiner has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in Applicants' disclosure a description of the invention defined by the claims. *In re Wertheim*, 191USPQ 90, 98 (CCPA 1976).

In the present case, Applicants assert that the specification, figures, and examples, i.e., the application, clearly conveys that which Applicants have invented and that subject matter which is claimed.

The Examiner's main position with respect to this rejection centers on the Examiner's understanding, and in Applicants opinion, the Examiner's misunderstanding, that both the viscosity of SGM-36 of Dow Corning of the instant application and that which is cited by Weijermars are viscosities by the same measurement, e.g., Newtonian or dynamic viscosity.

Applicants disagree with this position of the Examiner. Applicants submit the Declaration under 35 U.S.C. §1.132 by Jean-Louis Grossiord, who is one of skill in the art of the measurement of viscosity. Grossiord states that in the instant application, the viscosity measurements are oscillatory and are therefore the most potent and complete of the rheological tests. Defining a complex viscosity noted η^* which is sometimes referred to as viscoelastic viscosity to distinguish it from the steady flow viscosity η_0 . Complex viscosity is accurately mentioned in ordinate on Figure 2 of the instant application. Therefore, η^* is the modulus of a complex value the real part of which is noted η' which is often also named dynamic viscosity.

Applicants submit that Weijermars teaches the steady flow of SGM-36. This

provides a viscosity which is sometimes named dynamic viscosity, which is a viscosity that is highly dependent on shear conditions. For a shear thinning product like SGM-36, it can be defined by an area of very low shear for which the viscosity constant. It is often named the viscosity of the first Newtonian region which is noted η_0 . The name dynamic viscosity is derived from the fact it is kinematic viscosity ν which is equal to the dynamic viscosity η_0 (Newtonian viscosity) divided by the volume mass or density ρ of the sample:

$$\nu = \frac{\eta_0}{\rho}$$

Further, Applicants submit, as stated in the Declaration, that Table I of Weijermers, page 34, Newtonian viscosity is given as 5×10^4 Pa·s. This may result in a possible confusion between η_0 , η' and η^* which all have the same unit expression, i.e., Pa·s, in the International system of units. Despite the written similarities the units have very different meanings, which must be accounted for. The viscoelastic units η' and η^* depend from the frequency implemented in the oscillatory test, and further η' and η^* converge toward flowing viscosity η_0 when the oscillatory frequency is lowered towards to 0. It is the asymptotic behavior provided by the infinitely low frequency unit, which enables the three units to link.

Consequently, viscosity η_0 or Newtonian viscosity taught by Weijermars for SGM 36 is reported to be equal to $5 \cdot 10^4$ Pa·s, which is higher than the complex viscosity of η^* reported in Figure 2 of the instant application as a value of a little bit less than 10^4 Pa·s, namely 6.4×10^3 Pa·s, noting that the ordinate in Figure 2 is expressing in the logarithmic scale. This difference is perfectly understandable when it is considered that the oscillatory

testing is performed at a frequency of one Hz which is far from the low frequencies field. It is noted at [0029] of the instant published application that the viscosity curves translate measurements made in dynamic mode and represent a deformation on the abscissa and a dynamic viscosity along the ordinate. As previously noted, the dynamic viscosity is η^* .

It is also respectfully submitted that in Figure 2 of the instant specification the deformation γ given in the abscissa has no unit and the notation of Hz is a typographical error obvious to one of skill in the art.

Further, Applicants respectfully submit that the description of Figure 2 of the instant application at [0059] of the published application should be more completely understood as referencing the oscillatory viscosity (η^*) curve of the SGM-36® polymer by Dow Corning showing the deformation of gamma in abscissa in oscillation mode and the oscillatory viscosity η^* in Logarithmic scale in ordinate.

As such, Applicants respectfully submit that there is no contradiction between the complex dynamic viscosity η^* of the instant application and the Newtonian viscosity values taught by Weijermars. The instant specification conveys that Applicants were in possession of the invention. However, the Examiner has not met the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in Applicants' disclosure a description of the invention defined by the claims.

As such, Applicants respectfully request that the Examiner reconsider and withdraw the rejection.

REJECTION UNDER 35 U.S.C. §112, SECOND PARAGRAPH
– INDEFINITENESS

The Examiner has rejected claims 24, 26-35, 37-46, 48-56 and 58-65 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Examiner asserts that claims 24, 26-35, 37-46, 48-56 and 58-65 either recite or depend from a claim reciting a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation.

Applicants traverse this rejection. Claims 24, 35, 46, and 56 have been amended to remove the phrase “a dynamic viscosity of between 4,000 and 10,000 Pa·s at 25°C” thereby removing the broad range and thus the bases of the rejection. The remainder of the rejected claims in this part of the rejection, i.e., 26-34, 37-45, 48-55 and 58-65 depend either directly or indirectly from the amended claims. As such this portion of the rejection has been overcome.

The Examiner asserts that claims 30, 41, 52 and 62 indefinite due to the recitation of an intended function in the phrase “intended to reduce the sticky character of the drops”. Claims 30, 41, 52 and 62 have been cancelled. As such this portion of the rejection has been overcome.

The Examiner has rejected claims 55 and 65 as indefinite due to the recitation that the linear dimethiconol in the composition has “a viscosity of around 6,400 Pa·s at 25°C in solution in a volatile solvent comprising hexamethyldisilicone”. Claims 55 and 65 have been cancelled. As such this portion of the rejection has been overcome.

The Examiner has rejected claims 24, 35, 46, 55-56 and 65 as indefinite on the basis that the dimethiconol has a "viscosity around 6,400 Pa-s at 25°C" without defining the type of viscosity. Claims 55 and 65 have been cancelled, and the remaining claims have been amended to define the viscosity as "dynamic" viscosity. As such this portion of the rejection has been overcome.

Claim 42 has been rejected as indefinite based on a lack of antecedent basis for the phrase "said product". Claim 42 now reads "said composition" and the basis of the rejection is removed.

Claims 31, 53, and 63 are rejected as reciting the same product, with claim 31 indicating the product is a viscoelasticity modifying agent which cannot be present in the composition. Claims 53 and 63 have been cancelled, thereby removing the basis for this portion of the rejection.

Applicants respectfully submit that all bases of this rejection have been removed or otherwise overcome. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

REJECTION UNDER 35 U.S.C. §103(a)

I. Maksimoski et al.

The Examiner has rejected claims 24, 26-29, 31, 33-35, 37-40, 44-46, 48-51, 54-56, 58-61 and 64-65 are rejected as obvious over Maksimoski et al. in U.S. Patent No. 4,983,383. The Examiner states that Maksimoski teach a cosmetic formulation composed of silicone gum, inert particles, which the Examiner equates with the non-viscoelasticity modifying additive, and a volatile solvent, as recited in instant claims 24, 34-35, 45-46, 54, 56 and 64.

In view of the following, this rejection is respectfully traversed.

To establish a *prima facie* case of obviousness, the PTO must satisfy three requirements. First, as the U.S. Supreme Court very recently held in *KSR International Co. v. Teleflex Inc. et al.*, 550 U.S. 398 (2007), "a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions. ...it [may] be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. ...it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does... because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." See *KSR International Co. v. Teleflex Inc. et al.*, 550 U.S. 398 at 417-418. Second, the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *Amgen Inc. v. Chugai Pharm. Co.*, 18 USPQ2d 1016, 1023 (Fed. Cir. 1991). Lastly, the prior art references must teach or suggest all the limitations of the claims. *In re Wilson*, 165 USPQ 494, 496 (C.C.P.A. 1970).

The Examiner has broadly pointed to Maksimoski teaching non-solubilized particles in order to find a teaching according to the instant claims. Specifically, the Examiner matches the instant non-viscoelasticity modifying agent with the "non-solubilized

particulate” of Maksimoski.

Applicants direct the Examiner’s attention to the initial explanation given by Maksimoski for the “non-solubilized particles” i.e., the “particulate must be dispersed in the silicone gum, not solubilized in the hair care composition.” Col. 3, line 31. Thus, Applicants respectfully submit that it is plausible. Applicants directly point to col. 3, lines 65-66, which state that the particles are to be a size large enough to increase hair volume. Thus, it is possible that the particulate is modifying the composition of Maksimoski in a manner that acts to thicken it and could therefore act as a viscoelasticity-modifying agent. This is especially true since the compositions of Maksimoski are designed to modify the volume of hair, and such compositions are known in the art to be thick.

Additionally, the examples of particles in Maksimoski include: aluminum starch octenyl-succinate, (Dry Flo® - National Starch Company); acrylate/acrylamide copolymer (Ultra Hold 8® - BASF Corp.); polyvinyl methyl ether/maleic anhydride copolymer powder (Gantrez AN® - GAF Corp.); vinyl acetate/crotonic acid copolymer (Luviset CA-66® - BASF Corp.); titanium dioxide, calcium carbonate and talc. See, col. 4, lines 5-18. Applicants respectfully submit that the Examiner has failed to identify how these particles of Maksimoski compare to the non-viscoelasticity modifying agents of the instant application. In fact, the Examiner has provided no reasoning why the listed examples in Maksimoski would act as the non-viscoelasticity-modifying agents. Or why they would not. The Examiner has merely identified that Maksimoski correlates with the instant claims on this feature. On these grounds, Applicants respectfully submit that the particles of Maksimoski are not the instant non-viscoelasticity-modifying agents as claimed.

Each and every element of the instant claims is not shown in Maksimoski. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the outstanding rejection.

II. Krzysik et al. in view of Sandewicz et al.

The Examiner has rejected claims 24, 27, 30-32, 35, 38, 41, 43, 46, 49, 52-53, 56, 59, and 62-63 as obvious over Krzysik et al. in U.S. Patent No. 5,399,342 in view of Sandewicz et al. in U.S. Patent No. 6,451,329. The Examiner states that Maksimoski teaches a cosmetic formulation composed of silicone gum, inert particles, which the Examiner equates with the non-viscoelasticity modifying additive, and a volatile solvent, as recited in instant claims 24, 34-35, 45-46, 54, 56 and 64.

In view of the following, this rejection is respectfully traversed.

To establish a *prima facie* case of obviousness, the PTO must satisfy three requirements. First, as the U.S. Supreme Court very recently held in *KSR International Co. v. Teleflex Inc. et al.*, 550 U.S. 398 (2007), "a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions. ...it [may] be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. ...it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does... because inventions in most, if not all, instances

rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." See *KSR International Co. v. Teleflex Inc. et al.*, 550 U.S. 398 at 417-418. Second, the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *Amgen Inc. v. Chugai Pharm. Co.*, 18 USPQ2d 1016, 1023 (Fed. Cir. 1991). Lastly, the prior art references must teach or suggest all the limitations of the claims. *In re Wilson*, 165 USPQ 494, 496 (C.C.P.A. 1970).

The Examiner states that Krzysik teaches both dimethiconol as well as the volatile solvent. The Examiner further states that Sandewciz teaches dimethiconols, dimethicone/vinyl dimethicone cross polymer (a mixture of cyclomethicone D5 and a dimethicone polymer crosslinked by vinyl dimethicone). The Examiner states that Sandewciz teaches these to be included in the compositions to enhance the finish of the composition. The Examiner concludes that the finish of eyelashes is important so one of skill in the art would be so motivated to modify Krzysik in view of Sandewciz and use the enhancer thereof.

Applicants respectfully submit that the combination of references do not teach each and every element of the instant claims and specifically the combination fails to teach a composition for application to keratin fibres and intended to form drops on the keratin fibres. The instant application is directed to making compositions which enable drops to be deposited on keratin fibres, particularly on eyelashes and the hair, without having need to recourse to viscosifying agents in the composition. The Examiner has provided no states as to: why the total sum of the teachings of the references are directed to a fixed

viscosity or a viscosity which is not altered by additional non-viscoelasticity-modifying agents; and why the cited art compositions in whole or part would lead one of skill in the art to the instantly claimed subject matter. Again, the Examiner has relied on a broad understanding and subsequent statements to make the rejection. For this reason, Applicants respectfully submit that combination of Krzysik and Sandewciz does not teach each and every element of the instant claims.

Accordingly, the Examiner is respectfully requested to reconsider and withdraw the outstanding rejection.

CONCLUSION

If the Examiner has any questions or wishes to discuss this matter, the Examiner is welcomed to contact the undersigned attorney.

Respectfully submitted,

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